

REMARKS

Office Action's Claim Rejections Under 35 U.S.C. § 103

- 1. Rejections Based On Kearney, et al. Must Be Rescinded As This Reference Was Commonly Owned With The Invention Of The Instant Application At The Time Of Invention (35 U.S.C. 103(c)).**

The Office Action has indicated that claim 101-9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kearney et al. (U.S. Pat. No. 6,391,237)(hereinafter referred to as "Kearney") in view of Zeiter (U.S. Pat. No. 6,269,671) hereinafter referred to as "Zeiter").

35 U.S.C. §103(c) provides in relevant part:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.
35 U.S.C. §103(c); MPEP 706.02(l)(1)

It is well established that the Kearney reference qualifies as "subject matter developed by another person," due to the lack of identity between all the inventors of Kearney and those of the instant invention. Purdue Pharma L.P. v. Boehringer Ingelheim GmbH, 98 F. Supp. 2d 362, 380- 83, 55 U.S.P.Q.2d (BNA) 1168 (S.D. N.Y. 2000), *aff'd* and remanded, 237 F.3d 1359, 57 U.S.P.Q.2d (BNA) 1647 (Fed. Cir. 2001).

The Kearney reference is a prior filed U.S. patent, originating from a PCT application published in English, and later issued; and is therefore prior art under 35 U.S.C. §102(e)(2). See 35 U.S.C. §102(e)(2); MPEP 706.02(l)(1). At the time of the invention of the subject matter of the instant application (Appl. No. 10/075,824), and at all times relevant to these applications, both the instant application and the Kearney application/patent were owned by Assignment to R. P. Scherer Corp., a wholly owned subsidiary of Cardinal Health, Inc. of Dublin, OH.

The determination of the prior art date made in regards to the instant application in the Office Action mailed November 17, 2003 is no longer good law due to the passage of the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act). The CREATE Act was enacted on December 10, 2004, and is effective for all patents, including reissued patents, granted on or after the enactment date. In other words, it is effective for all patent applications pending, such as the instant application, on or after December 10, 2004. The CREATE Act also effectively makes the 1999 amendment to 35 U.S.C. 103(c) applicable to any applications filed prior to November 29, 1999 and were pending on December 10, 2004.

The Examiner is respectfully asked to take Administrative Notice of the records of Assignments in the United States Patent and Trademark Office in this regard, and Evidence for these averments are provided herein in the form of: Affidavit of Donald O. Nickey, Esq. (U.S.P.T.O. Reg. 29,092); Associate General Counsel for Intellectual Property, Cardinal Health, 7000 Cardinal Place, Dublin, Ohio, 43017; attesting to the fact that the Kearney application/patent (U.S. Pat. No. 6,391,237) and the instant application (10/075,824) were commonly owned by R. P. Scherer Corp. at the time of the filing of the instant application (10/075,824).

Accordingly, the Kearney reference must be disqualified as prior art for the purposes of a 35 U.S.C. §103 rejection. Accordingly, the rejection of claim 10 based on any combination which depends on Kearney must be rescinded.

Applicant further believes that no terminal disclaimer of patent term over that of Kearney is warranted, because the instant invention and that of Kearney do not constitute an instance of obviousness type double patenting. The question of obviousness-type double patenting, when posed with reference to two utility patents, is resolved by determining whether the claims of the later patent would have been obvious in view of the claims of the earlier patent, and not whether

the claims of either would be obvious in view of the claims of the other. Slade Gorton & Co., Inc. v. Millis, 62 F.3d 1433, 39 U.S.P.Q.2d (BNA) 1939, 1940–41 (Fed. Cir. 1995); In re Goodman, 11 F.3d 1046, 1052, 29 U.S.P.Q.2d (BNA) 2010, 2015 (Fed. Cir. 1993); Gerber Garment Technology, Inc. v. Lectra Systems, Inc., 916 F.2d 683, 686, 16 U.S.P.Q.2d (BNA) 1436, 1439 (Fed. Cir. 1990).

2. The Zeiter Reference is Insufficient to Support a 35 U.S.C. 103 Rejection.

The Zeiter (U.S. Pat. No. 6,269,671) reference cannot support a 35 U.S.C. §103 rejection on its own. MPEP 706.02(j) states the following relative to the contents of a 35 U.S.C. 103 rejection:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Zeiter fails all three tests. Taking the third requirement first, that a teaching must teach or suggest all the claim limitations, previous Office Actions have acknowledged that “Zeiter et al fail to disclose that the pin having [sic] a concave surface having a peripheral edge and indicia thereon.” (See, e.g., OA of 6/6/2005, page three, second paragraph.) Next, and closely allied, there is no teaching or suggestion in Zeiter that would serve as a motivation to modify Zeiter in such a fashion (i.e., a concave surface having peripheral edge and indicia). Lastly, as there is no teaching or suggestion leading to a motivation to modify, there can be no rational, much less reasonable, expectation of success in such modification.

For both of these reasons, that is, that the removal of Kearney under 35 U.S.C. §103(c) removes the primary predicate for the citation of Zeiter, and because Zeiter cannot itself provide adequate support for a 35 U.S.C. §103(a) rejection, the Zeiter reference should be withdrawn.

Conclusion

With the amendments to the claims and these arguments, it is the Applicants' position that each and every objection/rejection raised by the Examiner has been overcome. It is respectfully submitted that the claims are in a condition for allowance and allowance is respectfully solicited.

Should the Examiner have any questions or concerns prior to passing this case on to allowance, he is invited to contact Applicants' undersigned attorney.

Respectfully submitted,

Date:

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